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EXAMINER

IRSHADULLAH, M

ART UNIT PAPER NUMBER

3623

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,238

Applicant(s)

KANAGA, SAMANTHA J.

Examiner

M. Irshadullah

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a) Page 10, line 12: after "the action" insert "Number 41, description of the action 42", and
 - b) Page 11, line 18: insert "80" between "Report" and "is".

The above corrections are just a sample, Applicant is requested to review the specification more thoroughly to ensure that all typographical and other inconsistencies are rectified.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claims 1-6 are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in two prong test:

- (1) whether the invention is within the technological arts, and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

Art Unit: 3623

opposed to social sciences, for example) and, therefore, are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 merely recites abstract ideas. Recited steps of transmitting of documents, identifying parties, providing processing instructions, setting start end dates and determining state of compliance do not apply, involve, use or advance the technological art, since all of the steps can be performed in the mind of a user or by use of paper and pencil. The steps only constitute an abstract idea of facilitating a document escrow service.

Thus, the claimed invention is an abstract idea, produces useful, concrete and tangible result, the claimed invention as a whole is not within the technological art as explained above. Claim 1, therefore, deemed to be directed to non-statutory subject matter.

Claim 1 is, therefore, rejected under 35 U.S.C. 101, and same rationale holds for claims 2-6.

In order to overcome the rejection, it is suggested to recite computation device or computer within claim step or steps and claim language be amended in the light of above stated reasons.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3623

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Shkedy (US Patent 6,260,024 B1).

Shkedy discloses:

Claim 1. A method document escrow service, comprising the steps of:

a) transmitting a document set a trusted third party (Fig. 5, described col. 13, line 7 through col. 14, line 29, wherein cited "buyer clicking on send button and transmitting contract comprising elements, such as category of goods, particular items in the category, col. 13, lines 17-29" indicating reference's teaching "sending and transmitting" function, cited "contract" representing "document set" as indicated by: "a form displayed on buyer's monitor 430, the form is an electronic contract having selection fields, blanks etc., col. 13, lines 29-34, "another form {related to the contract} with pool dates selection

Art Unit: 3623

fields is presented to the buyer and legal language is added to make FPO 100 a contract, col. 14, lines 19-25" and "central controller 200" functioning as "third or trusted third party" between buyers and sellers as indicated by: "electronic network including central controller 200 and the network facilitating communications between buyers and sellers through an intermediary {central controller 200}, col. 4, lines 61-65");

b) identifying designated parties (Col. 21, lines 25-28, wherein "authenticating buyers/sellers by comparing their IDs with those in the respective databases 255 and 265" indicating reference's teaching "authenticating or identifying buyers or sellers representing designated parties");

c) providing detailed document processing instructions (Fig. 5, described col. 13, line 7 through col. 14, line 29, wherein cited "Fig. 5" depicting "the process {comprising instructions} for "generating and sending FPO 100" and as discussed above FPO 100 is contract or document, i.e.; reference's teaching the claimed limitation);

d) setting a process start date and a decision date (Col. 5, lines 35-38, wherein cited "buyer specifying pool dates and delivery dates" pointing to reference's teaching "specifying or setting" a "pool or starting dates" since the pool date is the date when seller bids, col. 14, lines 10-11, and "the delivery date" representing "decision date" for it is the date when transaction is completed: "central controller awarding bid and sending purchase confirmation to seller, the goods have been delivered, the transaction is complete, col. 6, lines 30-35");

e) transmitting the document set and the processing instructions to the designated recipients (Col. 16, lines 12-38, wherein cited "central controller 200

displaying PPO 110 web pages to most appropriate sellers {on their display means}, the PPO sent by e-mail etc.," indicating reference's teaching "sending or transmitting PPO to the appropriate or designated sellers or recipients" and the PPO is "a legal contract or document or document set" as indicated by: "before displaying PPO 110 to seller, central controller 200 adding legal language to make it explicit that seller is entering into a binding contract, col. 6, lines 9-28" and Figs 7 and 8, described col. 16, line 39 through col. 17, line 28" depicting the "process comprising instructions" the seller have to follow for actions on his part, such as viewing PPOs, categories and items thereon, developing bids and bidding etc.); and

f) determining a state of instruction compliance (Col. 4, lines 57-59, wherein cited "effectuating" in "reference system effectuating performance of the contracts" indicating reference's provisioning a function for "looking into or determining if the contract terms, conditions and above discussed instructions" are "effected or effectively followed and met or complied {a state of instruction compliance}" by the parties involved).

Claim 2. The method according to claim 1, wherein transmitting the document set to the trusted third party further comprises the step of providing a work title and a document number for the document set (Col. 13, lines 13-34 and col. 15, lines 6-7, wherein "central controller's web page showing categories of goods and services" indicating reference's provisioning "name or header or title or working title" of categories, or even FPO 100 representing the generic "name or title of a contract or document" of each buyer, "central controller adding a unique tracking number to FPO

Art Unit: 3623

100, col. 15, lines 6-7" indicating reference's teaching "FPO or document number" and as discussed above "FPO 100" representing "document set").

Claim 3. The method according to claim 1, wherein identifying designated recipients further comprises the step providing information such as an address, a fax number and a telephone number for each of the designated recipients (Col. 10, lines 11-17, wherein cited "sellers" representing "designated parties or recipients" and cited sellers "contact information including phone number etc." indicating reference's teaching claimed limitation).

Claim 5. The method according to claim 1, wherein determining a manner of termination comprises step setting a process end date and establishing that termination shall occur upon instruction compliance (Col. 6, lines 29-34, wherein cited "awarding bid to requisite seller, central controller send confirmation of purchase to seller and delivery of goods {from seller to buyer}" indicating reference's teaching "completion or termination" of the transaction happening or occurring process at the above discussed "goods delivery or end date", and the delivery or end date is provided or established by the system buyer, in other words reference teaching "providing or setting a process end date and fixing or establishing the completion or termination of the process when above delivery is done as per above discussed instructions {upon instruction compliance}: delivery of goods from seller to buyer ending the process, col. 27, lines 31-33").

Claim 6. The method according to claim 1, wherein determining state of the instruction compliance further comprises the step of summarizing each instruction and compliance therewith (Col. 19, lines 16-23, wherein cited "monthly statement containing billable amounts" indicating reference's teaching "a statement" and the statement by definition is structured for providing "abstract or summary" of transactions, and a user would use the statement for claimed purpose).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (US Patent 6,260,024 B1).

Shkedy teaches:

Claim 4. The method according claim 1, wherein providing detailed document processing instructions further comprises the steps of:

a) providing a list of involved parties (Fig. 2 {Buyer database 255 and Seller database 260} , described col. 10, lines 1-25, wherein cited "databases 255 and 260 maintaining data or information on buyers and sellers" indicating reference's teaching "maintaining or providing data or information" relating to "buyers and sellers or involved

Art Unit: 3623

parties” and according to database jargon, information or data in a database are stored in “file, table or list” format);

b) choosing specific provided actions for each party (Col. 7, lines 27-46, wherein cited intermediary “specifying pre-negotiated terms in a contract, such as seller beating competitor prices and signing of a contract by multiple persons” indicating reference’s teaching “specifying or selecting or choosing particular or specific actions” performed by relative “seller and buyer entities involved” or “for each party”).

In the following element:

c) providing comments for each instruction.

Shkedy teaches:

attaching buyer name or ID to FPO (Col. 13, lines 62-63) and seller appending time-stamp to seller’s bid or response (Col. 17, lines 8-10) and buyer selecting categories, items etc., from a web page (Col. 13, lines 13-31).

Shkedy does not explicitly teach:

providing comments for each instruction.

Official notice is taken that attaching or appending or providing remarks or comments to some thing is an old and well known practice in the computer art.

It would have been obvious to one of ordinary skill in the computer art at the time of Applicant’s invention to advantageously adding a requisite icon in reference’s menu, thereby enabling a user to attach, append remarks relative to any thing including claimed instructions.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Heffner et al., US Patent 2003/0018558 A1. System, Method and computer Product For Online Financial Products Trading.

B) Crawford et al., US Patent 6,502,113 B1. Negotiation Manager Incorporating Clause Modification And Markers For tracking Negotiation Progress.

C) Huberman, US Patent 6,078,906. Method And System For Providing A Document Service Over a Computer Network Using An Automated Brokered Auction.

D) Huberman, US Patent 5,826,244. Method And System For Providing A Document Service Over a Computer Network Using An Automated Brokered Auction.

E) Gower, US Patent 5,535,383. Database System With Methods For Controlling Object Interaction By Establishing Database Contracts Between Objects.

F) Bronnenberg et al., US Patent 5,479,269. Automated form Handling And Generating System And A Form Sheet Associated To Said System.

G) Abecassis, US Patent 5,426,281. Transaction Protection System.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Irshadullah whose telephone number is 571-272-6731. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. Irshadullah
April 20, 2005



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